

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

Summary of the Office Action

The title stands objected to. ✓

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* (U.S. Patent No. 6,278,670) with the allegedly acknowledged “normalized” methodology in the “STANDARD DVD BOOK.” xx

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* in view of the “STANDARD DVD BOOK” and further in view of *Kasami et al.* (U.S. Patent No. 6,312,780).

Summary of the Response to the Office Action

Claim 4 has been canceled without prejudice or disclaimer. Claim 1 has been amended and claims 6 and 7 have been newly added by this amendment. Accordingly, claims 1, 6 and 7 are currently pending. ✓

Objection to the Title

The title stands objected to by the Final Office Action. Applicants have amended the title in the Amendment under 37 C.F.R. §1.116 filed on April 4, 2003 by including the phraseology of “normalized detector size” as recommended by the Examiner. The Advisory Action dated April 16, 2003 gave no indication that the Amendment under 37 C.F.R. §1.116 filed on April 4, 2003 was not entered. Accordingly, it is Applicants’ understanding that the April 4, 2003 Amendment was entered. Thus, withdrawal of the objection to the title is respectfully requested ✓

in the next Office Communication. If Applicants' understanding is inaccurate, Applicants respectfully request that the Amendment filed on April 4, 2003 be entered at this time.

Claim Rejections Under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* with the allegedly acknowledged "normalized" methodology in the "STANDARD DVD BOOK." Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* in view of the "STANDARD DVD BOOK" and further in view of *Kasami et al.* These rejections are respectfully traversed for at least the following reasons.

As an initial matter, claim 4 has been canceled without prejudice or disclaimer, thereby rendering the rejection of claim 4 moot. Also, claim 1 has been amended to incorporate the limitation of claim 4. Applicants respectfully submit that an embodiment of the present invention as recited in claim 1, as newly-amended, includes an objective lens having a numerical aperture of 0.85 or greater. ✓

The Final Office Action applies the STANDARD DVD BOOK under 35 U.S.C. §103(a). In the April 4, 2003 Amendment, Applicants respectfully submitted that in order for a reference to be properly applied under 35 U.S.C. §103, that reference must qualify as prior art under some section of 35 U.S.C. §102. Applicants respectfully submitted that because they are not able to duplicate portions of the STANDARD DVD BOOK, as per contractual arrangement with the DVD Forum, the STANDARD DVD BOOK is not a publicly available document. ✓

In response, the Advisory Action cites *In re Nomiya*, 509 F.2d 566, 184 U.S.P.Q. 607 as allegedly providing basis for applying the STANDARD DVD BOOK as prior art against the present application. However, *In re Nomiya* relates to a situation involving a patent application

containing Figs. 1 and 2 labeled as prior art, and associated statements made by the appellants during prosecution. The court found that the appellants had conceded that the structure shown in Figs. 1 and 2 was prior art by labeling Figs. 1 and 2 as such. See *id.* at 571. ✓

In contrast to *In re Nomiya*, Applications respectfully submit that no portion of the present application refers to the STANDARD DVD BOOK as prior art. Accordingly, Applicants respectfully submit that the decision of *In re Nomiya* is not applicable to facts associated with the present application and that the STANDARD DVD BOOK should not be considered as prior art against the present application based on *In re Nomiya*. ✓

In addition, the Final Office Action interprets claim 1 as an apparatus using the methodology described in the STANDARD DVD BOOK. In the April 4, 2003 Amendment, Applicants respectfully submitted that the STANDARD DVD BOOK fails to teach or suggest the claimed combination as set forth in claim 1 including at least the photodetector having “a normalized detector size (B/β^2) in a size of $10\ \mu\text{m}^2$ to $50\ \mu\text{m}^2$.” In response, the Advisory Action cites *In re Peterson*, 315 F.3d 1325, 65 U.S.P.Q. 2d 1379 as allegedly providing basis for rejecting Applicants’ arguments in this regard. However, *In re Peterson* relates to a situation involving a patent application containing overlapping elements with a cited reference and claiming narrower ranges of the overlapped elements in comparison with the cited reference. ✓

The court found that a *prima facie* case of obviousness was made because selecting a narrow range from within a somewhat broader range disclosed in a prior art reference is no less obvious than identifying a range that simply overlaps a disclosed range. See *id.* at 1329-1330.

In contrast to *In re Peterson*, the claimed combination as set forth in independent claim 1 includes a range of a normalized detector size which does not overlap with the STANDARD

DVD BOOK. Accordingly, Applicants respectfully submit that the decision of *In re Peterson* is also not applicable to facts associated with the present application. Also, Applicants respectfully submit that even assuming, *strictly arguendo*, that the STANDARD DVD BOOK were prior art against the present application, the claimed combination as set forth in claim 1, including at least the photodetector having “a normalized detector size (B/β^2) in a size of $10\ \mu\text{m}^2$ to $50\ \mu\text{m}^2$ ” still differs and is not obvious from the disclosure of the STANDARD DVD BOOK or ECMA-267 (Exhibit A submitted on April 4, 2003).

Further, it is respectfully submitted that *Hayashi et al.* and *Kasami et al.* are not relied upon to teach a normalized detector size, and do not remedy the deficiency of the STANDARD DVD BOOK.

Since, in view of the above, *Hayashi et al.*, the STANDARD DVD BOOK, and *Kasami et al.*, whether taken singly or in combination, fail to teach or suggest each and every element set forth in claim 1, it is respectfully submitted that *Hayashi et al.*, the STANDARD DVD BOOK, and *Kasami et al.*, whether taken singly or in combination, do not render claim 1 unpatentable. Accordingly, withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) is respectfully requested.

New Claims 6-7

Applicants have added new claims 6 and 7 to differently define the present invention. Applicants respectfully submit that claim 6 is supported by, for example, the discussion at page 7, lines 20-27, page 11, lines 14-21, and page 11, line 27-page 12, line 5 of the specification. In addition, Applicants respectfully submit that claim 7 is supported by, for example, the discussion at page 8, lines 9-16, and page 15, lines 4-8 of the specification. Moreover, Applicants

respectfully submit that claims 6 and 7 are allowable at least because of their dependence from claim 1.

Conclusion

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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